

Appln No. 09/877,817

Amdt date October 24, 2005

Reply to Office action of July 27, 2005

**REMARKS/ARGUMENTS**

Claims 1-24 were pending in the application when examined, of which claims 1, 6, 10, 11, 16, and 21 are independent. Claims 1-8, 16, 22, and 24 have been amended. No claims have been canceled. New claims 25 and 26 have been added. The amendments find full support in the original specification, claims, and drawings. No new matter has been added. Claims 1-26 are now pending in this application.

The Examiner has allowed claims 6-10. The Examiner has rejected claims 1-5 and 11-24 under 35 U.S.C. §102(e) as being anticipated by Catona (U.S. Patent No. 6,288,319).

Claim 1 has been amended to call for "transmitting the voice dedication message and a song selected based on the song selection to the recipient at the recipient address, wherein the recipient is capable of listening to the voice dedication message separately from the song." (Emphasis added). Catona does not teach or suggest this limitation.

Catona is directed to singing along to a pre-recorded music track. According to Catona, "a karaoke-style implementation is used, wherein the song is played while the user sings the vocal track." (Catona, Col. 2, lines 58-60). Catona teaches sending a karaoke-style "voice-over" which effectively sends a new recording of the song to the recipient. In order to generate the new recording, the user selects a pre-recorded song from the song database and the song is downloaded to the user's client computer. The user then "records the vocal track 40 to accompany the song ... [,] the pre-recorded song and the vocal track are mixed ... [, and] the mixed track 44 is sent to the

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server computer." (Catona, Col. 3, lines 20-50). A recipient of the recording, however, cannot listen to the vocal track separately from the song. Accordingly, Applicant submits that claim 1, as amended, is in condition for allowance.

Claims 2-5 and 24 depend from claim 1 and are in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained in these claims.

For example, regarding claim 4, the Examiner contends that Catona teaches transmitting a confirmation to the sender at the sender address in column 3, lines 41-50 and column 4, lines 41-46. (Office Action, p. 3, par. 2.4). These passages of Catona, however, merely reiterate the method of retrieval of the message by the recipient using an URL. They do not disclose a confirmation being sent back to the sender.

Regarding claim 5, the Examiner agrees that Catona does not explicitly disclose receiving from the sender a telephone message for use as the voice dedication message. (Office Action, p. 4, par. 2.5). However, the Examiner contends that Catona does disclose capturing the custom audio data at the client in column 4, lines 1-20 and in its figure 5. (Ibid.) The Examiner concludes that the voice dedication message can be captured in a variety of well-known methods including remotely by telephone. There is nothing in Catona, however, that ever hints at this possibility. The cited passage simply mentions that the user sings into a microphone that is connected to a recorder and the audio track is then sent to the server. The associated figure in Catona also shows the microphone and the

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recorder both as parts of the client computer and not as separate entities.

Independent claim 11 recites "receiving from the sender, recipient address information; generating an identification number ... sending the identification number to the recipient using the recipient address information ... generating a document using the identification number, the document including: song retrieval instructions; and voice message retrieval instructions; and sending the document in response to the request." (Emphasis added). In Catona, "generating an identification number" and "generating a document ... including song ... and voice message retrieval instructions" are not done by the same entity. The server generates the URL or the email to be sent to the recipient while the mixing or generating the document that is sent to the recipient is done at the client site. Catona, therefore, does not teach all of the limitations of claim 11. Accordingly, Applicant submits that claim 11 is in condition for allowance.

Claims 12-15 depend from claim 11 and are in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained in these claims.

For example, Catona does not disclose "sending a notification to the sender using the sender address information" of claim 12, or "using the song selection to indicate the song linked by the identification number to the voice message" of claim 14, or "receiving song selection criteria from the sender" of claim 15. (Emphasis added). As presented above, Catona does not disclose a notification or confirmation function. Further,

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Catona's client receives the song and mixes it with the vocals and sends back the mix so there is no need for an "identification number" to "link" the two together. Finally, there is no "song selection criteria" in Catona. Rather, Catona's sender must know which song he wants and must ask for it by name. (See, Catona, Col. 3, lines 20-35).

Amended claim 16 recites "generating an identification number; associating a song and a voice message using the identification number ...." Catona does not disclose these limitations. In Catona, the song is brought into the client computer and is mixed with the vocals so that by the end of the process, the song and the voice message are one and the same. The song and the voice message of Catona need not be associated together using another mechanism of association. Accordingly, Applicant submits that claim 16, as amended, is in condition for allowance.

Claims 17-19 depend from claim 11 and are in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained in these claims.

For example, claim 17 includes a "notification to the sender," claim 19 includes a "song selection list," and claim 20 includes a "song selection criteria," that are not disclosed by Catona as presented above.

Claim 21 recites "receiving from the sender, song selection criteria; generating a song selection list from the song selection criteria, sending the song selection list to the sender ... associating a song indicated by the song selection and the voice message using the personal identification number

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...." (Emphasis added). As discussed above, Catona does not teach a "song selection criteria" or "generating a ... list". Further, because in Catona the vocals are mixed with the song, they are automatically associated together and there is no need to associate the two using an "identification number." Accordingly, Applicant submits that claim 21, as amended, is in condition for allowance.

Claims 22 and 23 depend from claim 21 and are in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained in these claims.

New claims 25 and 26 have been added that depend from claim 1 and are allowable based on claim 1. Additionally, claim 25 recites that "the song and the voice dedication are not mixed." Claim 26 recites that "the voice dedication message is separately retrievable from the song." Catona does not teach or suggest these limitations. In Catona, "the pre-recorded song and the vocal track are mixed," and "the mixed track 44 is sent to the server computer." (Catona, Col. 3, lines 35-40). Accordingly, Applicant submits that new claims 25 and 26 allowable.

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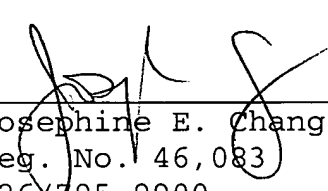
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In view of the above amendments and remarks, Applicants respectfully request reconsideration, reexamination, and an early indication of allowance of the now pending claims 1-26.

Respectfully submitted,

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